IGTECH.0005P

PATENT

# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| Applicant | : | LeMay, et al. | ) |
| | | | ) |
| Appl. No. | : | 09/823,833 | ) |
| | | | ) |
| Filed | : | March 30, 2001 | ) |
| | | | ) |
| For | : | METHOD AND APPARATUS FOR DOWNLOADING PERIPHERAL CODE | ) ) ) |
| | | | ) |
| Examiner | : | Aaron L. Enatsky | ) |

Group Art Unit 3713

09/04/2003 DTESSEH1 00000081 09823833

01 FC:1251                        110.00 OP     **RESPONSE TO OFFICE ACTION**

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is in response to the Office Action mailed May 6, 2003 with respect to the above-referenced application. A one-month extension is requested and the appropriate fee is enclosed.

By the Office Action, the Examiner rejected Claims 37-49 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,263,392 to McCauley in view of Request for Comments: 951 by Croft et al., alone or in further view of U.S. Patent No. 6,052,779 to Jackson et al. or U.S. Patent No. 5,802,592 to Chess et al.

Most importantly, Applicants assert that the invention as claimed is fundamentally different than detailed in base reference, McCauley, and moreover, that the present invention is not obvious in view of the cited combinations.

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As detailed previously, a fundamental aspect of the present invention is a peripheral device which normally does not include resident operating code which fully enables operation of the device. Instead, this code is provided to the device.

As McCauley discloses, in prior systems, each peripheral device is associated with a microcontroller. The microcontroller comprises an interface between a peripheral device and an HID compliant host computer, the microcontroller generating HID report descriptors and the like. As disclosed, this system thus requires multiple microcontrollers when multiple peripheral devices are used, a configuration which is "uneconomical." See McCauley at Col. 1, line 55 to Col. 2, line 13.

McCauley thus teaches a configuration where a hub or interface is provided between peripheral devices and a USB connection to a HID compliant host computer. In this configuration, multiple peripheral devices are connected to the single interface or hub, the hub or interface in turn communicating via the USB connection with the computer. See McCauley at Col. 5, lines 46-52.

McCauley's configuration is premised upon the ability to connect standard HID peripheral devices, such as joysticks, trackballs and the like to the interface. In other words, in McCauley, fully functioning peripheral devices are connected to the interface. As the Examiner acknowledges, in this configuration, each peripheral already includes its own operating code for generating peripheral data packets, and no code is or needs to be downloaded to the peripheral device. See McCauley at Col 5, line 61 to Col. 6, line 6, and Col. 6, lines 22-34.

Another aspect of McCauley is that, because standard peripherals are connected to the interface, a means is provided for identifying those peripherals. As detailed, the interface includes a plurality of different connectors for supporting various types of peripheral devices. See McCauley Col. 9, lines 34-42. In operation, the identity of a particular peripheral is known by connection of a peripheral to a particular type of connector. See McCauley Col 9, lines 56-59.

The configuration of McCauley will thus be appreciated to be substantially different from that of the invention as claimed in Claims 37-49. The Examiner asserts that the present invention is obvious when the teaching of Croft is applied to McCauley. Applicant asserts, however, that the proposed combination does not teach the present invention and, moreover, is not proper.

The Examiner asserts that Croft teaches a system in which a client machine is configured to send a request to a server machine, and in response to that request the server machine transmits back a bootfile. The Examiner then asserts that "one would be motivated to modify McCauley to include automatic operating code downloads in peripheral devices taught by Croft . . ."

This combination, however, flies in the face of McCauley and McCauley's teachings. First and foremost, McCauley does not teach peripheral devices which have a memory for accepting downloaded code. To the contrary, McCauley teaches a system which is designed to work with standard peripheral devices such as joysticks and the like which already have resident code. In fact, this is the whole point of McCauley: McCauley's invention is an interface which is capable of generating HID report descriptors and the like (for use by the host computer) from the various different peripheral data packets/signals generated by the different peripheral devices. In other words, McCauley is a "plug and play" configuration where a hub or interface supports multiple

standard, stand-alone peripherals (i.e. the peripheral already has all necessary operation code). See e.g. McCauley Col. 9, line 56 to Col. 10, line 12. Thus, the configuration of Croft could not apply to McCauley since the peripheral devices with which McCauley is intended to operate are not of the "download" type.

In addition, if the Examiner is suggesting that McCauley should be modified to include both a download feature and downloading peripherals, then once again this combination is improper. Among other things, such a combination is not suggested in either reference, and McCauley teaches away from such a configuration. Again, McCauley's invention is directed to a method of simplifying the connection of many standard peripherals - i.e. in a "plug and play" configuration. This configuration is completely undermines the entire purpose of McCauley, which is the compatibility of use of any stand-alone peripheral. Further, such a system would complicate the system of McCauley by requiring that the host computer maintain code for each and every potential peripheral which is connected to the system. As noted, McCauley's invention is directed to simplifying the connection of peripherals.
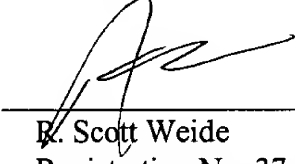
Lastly, Applicants note that Croft is directed to a very specific problem: that of a client device finding its own IP address, finding the IP address of a server/host, and discovering the name of a file to be loaded into memory and executed. Applicants invention is not concerned with IP addressing. Applicants' further assert that there is no apparent teaching of Crofts' method/system to a system such as McCauley which, as detailed above, addresses entirely different problems and has entirely different configurations than that of Croft.
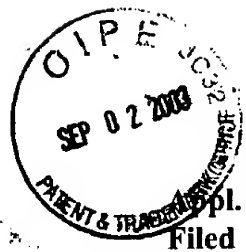
Appl. No.    :    09/823,833
Filed        :    March 30, 2001

For these reasons, Applicants assert that Claims 37-49 of the present invention are not obvious

in view of the cited references, but instead define patentably distinct subject-matter.

Respectfully submitted,

Dated: _August 29, 2003_    By: _____

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# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| Applicant | : | LeMay, et al. | ) | Group Art Unit: 3713 |
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| Appl. No. | : | 09/823,833 | ) | I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on: |
| Filed | : | March 30, 2001 | ) | |
| For | : | **METHOD AND APPARATUS FOR DOWNLOADING PERIPHERAL CODE** | ) | August 29, 2003 <br> (Date) |
| | | | ) | Mary Burr <br> Mary Burr |
| Examiner | : | Aaron L. Enatsky | ) | |

## TRANSMITTAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith is:

(X)  A Response to Office Action in 5 pages;
(X)  A check in the amount of $110.00 for the one-month extension fee; and
(X)  A return prepaid postcard.

| CLAIMS AS FILED | | | | | | |
|---|---|---|---|---|---|---|
| | CLAIMS REMAINING AFTER AMENDMENT | | HIGHEST NO. PREVIOUSLY PAID FOR | PRESENT EXTRA | RATE | ADDITIONAL FEE |
| Total Claims | 13 | MINUS | 20 | = 0 × | $18 | = $ 0 |
| Independent Claims | 2 | MINUS | 3 | = 0 × | $84 | = $ 0 |
| One-Month Extension | | | | | | = $110.00 |
| | | TOTAL ADDITIONAL FEE FOR THIS AMENDMENT | | | | $110.00 |
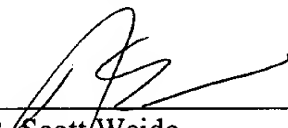
(X) **The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Account No.: 502200. A duplicate copy of this sheet is enclosed.**

Respectfully submitted,

Dated: _August 29, 2003_        By: _____

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